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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/015,675	12/17/2001	Isao Ota	111483	5111

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OLIFF & BERRIDGE, PLC
P.O. BOX 19928
ALEXANDRIA, VA 22320

EXAMINER

UMEZ ERONINI, LYNETTE T

ART UNIT

PAPER NUMBER

1765

DATE MAILED: 04/12/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

**Advisory Action
Before the Filing of an Appeal Brief**

Application No.

10/015,675

Applicant(s)

OTA ET AL.

Examiner

Lynette T. Umez-Eronini

Art Unit

1765

--The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

THE REPLY FILED 15 March 2005 FAILS TO PLACE THIS APPLICATION IN CONDITION FOR ALLOWANCE.

1. ☒ The reply was filed after a final rejection, but prior to filing a Notice of Appeal. To avoid abandonment of this application, applicant must timely file one of the following replies: (1) an amendment, affidavit, or other evidence, which places the application in condition for allowance; (2) a Notice of Appeal (with appeal fee) in compliance with 37 CFR 41.31; or (3) a Request for Continued Examination (RCE) in compliance with 37 CFR 1.114. The reply must be filed within one of the following time periods:

- a) ☐ The period for reply expires _____ months from the mailing date of the final rejection.
b) ☒ The period for reply expires on: (1) the mailing date of this Advisory Action, or (2) the date set forth in the final rejection, whichever is later. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of the final rejection.

Examiner Note: If box 1 is checked, check either box (a) or (b). ONLY CHECK BOX (b) WHEN THE FIRST REPLY WAS FILED WITHIN TWO MONTHS OF THE FINAL REJECTION. See MPEP 706.07(f).

Extensions of time may be obtained under 37 CFR 1.136(a). The date on which the petition under 37 CFR 1.136(a) and the appropriate extension fee have been filed is the date for purposes of determining the period of extension and the corresponding amount of the fee. The appropriate extension fee under 37 CFR 1.17(a) is calculated from: (1) the expiration date of the shortened statutory period for reply originally set in the final Office action; or (2) as set forth in (b) above, if checked. Any reply received by the Office later than three months after the mailing date of the final rejection, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

NOTICE OF APPEAL

2. ☐ The reply was filed after the date of filing a Notice of Appeal, but prior to the date of filing an appeal brief. The Notice of Appeal was filed on _____. A brief in compliance with 37 CFR 41.37 must be filed within two months of the date of filing the Notice of Appeal (37 CFR 41.37(a)), or any extension thereof (37 CFR 41.37(e)), to avoid dismissal of the appeal. Since a Notice of Appeal has been filed, any reply must be filed within the time period set forth in 37 CFR 41.37(a).

AMENDMENTS

3. ☒ The proposed amendment(s) filed after a final rejection, but prior to the date of filing a brief, will not be entered because
(a) ☒ They raise new issues that would require further consideration and/or search (see NOTE below);
(b) ☐ They raise the issue of new matter (see NOTE below);
(c) ☐ They are not deemed to place the application in better form for appeal by materially reducing or simplifying the issues for appeal; and/or
(d) ☐ They present additional claims without canceling a corresponding number of finally rejected claims.

NOTE: See Continuation Sheet. (See 37 CFR 1.116 and 41.33(a)).

4. ☐ The amendments are not in compliance with 37 CFR 1.121. See attached Notice of Non-Compliant Amendment (PTOL-324).

5. ☐ Applicant's reply has overcome the following rejection(s): _____.

6. ☐ Newly proposed or amended claim(s) _____ would be allowable if submitted in a separate, timely filed amendment canceling the non-allowable claim(s).

7. ☐ For purposes of appeal, the proposed amendment(s): a) ☐ will not be entered, or b) ☐ will be entered and an explanation of how the new or amended claims would be rejected is provided below or appended.

The status of the claim(s) is (or will be) as follows:

Claim(s) allowed: none.

Claim(s) objected to: none.

Claim(s) rejected: 1-3, 10 and 12-18.

Claim(s) withdrawn from consideration: 11.

AFFIDAVIT OR OTHER EVIDENCE

8. ☐ The affidavit or other evidence filed after a final action, but before or on the date of filing a Notice of Appeal will not be entered because applicant failed to provide a showing of good and sufficient reasons why the affidavit or other evidence is necessary and was not earlier presented. See 37 CFR 1.116(e).

9. ☐ The affidavit or other evidence filed after the date of filing a Notice of Appeal, but prior to the date of filing a brief, will not be entered because the affidavit or other evidence failed to overcome all rejections under appeal and/or appellant fails to provide a showing of good and sufficient reasons why it is necessary and was not earlier presented. See 37 CFR 41.33(d)(1).

10. ☐ The affidavit or other evidence is entered. An explanation of the status of the claims after entry is below or attached.

REQUEST FOR RECONSIDERATION/OTHER

11. ☒ The request for reconsideration has been considered but does NOT place the application in condition for allowance because: See Continuation Sheet.

12. ☒ Note the attached Information Disclosure Statement(s). (PTO/SB/08 or PTO-1449) Paper No(s). _____

13. ☐ Other: _____.

**NADINE G. NORTON
SUPERVISORY PATENT EXAMINER**

Continuation of 3. NOTE:

In (Withdrawn-Currently Amended) Claim 11, "--An abrasive according to claim 10, wherein-- the sol --is produced-- . . ." raises new issues that would require further consideration. Also the said claim is directed to an invention that is independent or distinct from the invention originally claimed for the following reasons: Applicants have originally elected claims 1-3, 10, and 12-18, which are drawn to an abrasive sol, classified in claim 252/79.1 and which differs from the newly submitted claim 11, which is drawn to an abrasive sol made by a method, classified in 51/307.

Continuation of 11. does NOT place the application in condition for allowance because:

Applicants request to reconsider the restriction requirement in the Office Action of December 15, 2004, between Group I, claims 1-3, 10, and 12-18 and Group II, claim 12 because the restriction of claim 12 is baseless and illogical since the claim cannot both include and exclude a given step or element is unpersuasive.

Applicant's argument is unpersuasive because the inventions are distinct because (i) in the instant case the process as claimed can be used to make other and materially different product such as a sol comprising additional components that excludes (or does not require) lanthanum and neodymium and (ii) based on the classification of Group II, claim 12 would require a different search from the originally presented Group I, claims 1-3, 10, and 12-18. Also, the separate classification status of Group I and Group II claims would be a burden to the Examiner in searching different inventions. Hence, the restriction is proper.

Applicants traverse the 103(a) rejection of claims 1-3, 10, and 12-18 over Tatsu et al. (US 4,769,073) in view of Aozasa (US 6,171,572) because Aozasa fails to make up Tatsu's deficiency of disclosing wherein the particles have a particle size of 50 to 150 nm. Applicants argue the Aozasa reference discloses an average particle size between 3 nm and 100 nm is necessary to compound zirconium oxide easily.

Applicants' argument is acknowledged and unpersuasive since Aozasa teaches a sol having a particle size of 3 to 100 nm which falls within the range of particle sizes as claimed by applicants, then it would have been obvious to one having ordinary skill in the art at the time of the claimed invention to modify Tatsu's sol by employing a sol having particle sizes within the range as claimed by applicants for the purpose of ease of production on an industrial scale (column 8, lines 42-45).

It is noted that the above addresses the requests made by applicants' representative in the Interview Summary of 4/1/2005, in which requests were made that if Claim 11 is not entered, then reason(s) for not entering be sent in the next Office action and to reconsider arguments.